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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/533,290

02/07/2006

Thor Las Holtet

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6045

20306

7590

03/09/2010

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EXAMINER

MERTZ, PREMA MARIA

ART UNIT

PAPER NUMBER

1646

MAIL DATE

DELIVERY MODE

03/09/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/533,290	<b>Applicant(s)</b> HOLTET ET AL.	
	<b>Examiner</b> Prema M. Mertz	<b>Art Unit</b> 1646	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12/24/09, 2/15/2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1, 19, 20, 22, 23, 30 and 35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 19-20, 22-23, 30, 35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

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### **DETAILED ACTION**

1. Claims 2-17, 21 have been cancelled previously. Claim 18 has been canceled I the amendment filed 2/15/2010.

Amended claim 1 (2/15/2010) and previous claims 19-20, 22-23, 30, and 35 are pending and under consideration by the Examiner.

2. Receipt of applicant's arguments and amendments filed on 2/15/2010 and 12/24/2009 is acknowledged.

3. The following previous rejections and objections are withdrawn in light of applicants amendments filed on 1/15/2009:

(i) the rejection of claims 1, 18-23, 30, 35, under 35 U.S.C. 112, first paragraph, written description; and

(ii) the rejection of claims 1, 18-23, 30, 35, under 35 U.S.C. 112, first paragraph, scope of enablement.

4. Applicant's arguments filed on 12/24/09 and 2/15/2010 have been fully considered and were persuasive in part. The issues remaining are stated below.

#### ***Claim rejections-Double Patenting***

##### ***Non-statutory double patenting rejection (obviousness-type)***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

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improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5a. Claims 1, 19-20, 30, are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 56-68 of copending Application No. 11/452,434 ('434). Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 56-64, 80-81 of copending Application No. 11/452,434 (having one common inventor with the instant application), claims a trimeric polypeptide complex comprising three monomer polypeptides, wherein (i) each of said monomer polypeptides comprises a tetranectin trimerising structural element (TTSE), said TTSE being a polypeptide having at least 68% amino acid sequence identity with the consensus sequence shown in SEQ ID NO:40 and (ii) at least one of said monomer polypeptides is covalently linked to at least one heterologous moiety, where said at least one heterologous moiety is different from

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any of the fusion proteins CIIH6FXTN123, H6FXTN123, H6FXTN12, H6FXTN23, the sequences of which are shown in SEQ ID NOs:24-27, and said complex remains as a trimer at a temperature of at least 60°C.

This rejection is maintained for reasons of record set forth at pages 9-11 of the previous Office action (8/22/2008), pages 14-16 of the previous Office action (2/12/2009) and pages 10-12 of the previous Office action (7/24/09).

Applicants argue that they acknowledge the provisional rejection under the doctrine of obviousness-type double patenting, and elect to address this ground of rejection upon notification that this rejection has been made non-provisional, all other conditions for patentability have been met, and the instant claims are otherwise in condition for allowance. However, contrary to Applicants arguments, the instant claims will never be allowable unless a terminal disclaimer is filed to obviate the provisional nonstatutory obviousness-type double patenting rejection.

### ***Conclusion***

No claim is allowed.

Claims 1, 19-20, 22-23, 30, 35, are rejected.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Advisory Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prema Mertz whose telephone number is (571) 272-0876. The examiner can normally be reached on Monday-Friday from 7:00AM to 3:30PM (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Nickol, can be reached on (571) 272-0835.

Official papers filed by fax should be directed to (571) 273-8300. Faxed draft or informal communications with the examiner should be directed to (571) 273-0876.

Information regarding the status of an application may be obtained from the Patent application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Prema Mertz/  
Prema Mertz, Ph.D., J.D.  
Primary Examiner  
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